

Remarks

Non-elected Claims 1 - 24 have been cancelled. The remaining independent claims have been amended to recite administration of trans-10-hydroxy-2-decenoic acid. Claim 27 has been additionally amended to delete reference to regenerating skin. Finally, new dependent Claims 31 - 44 have been added. As the amendments find clear support in the specification as originally filed, no new matter is believed to be added.

Rejection under 35 U.S.C. § 112

The Applicants appreciate the Examiner's indication that the specification provides ample enablement for trans-10-hydroxy-2-decenoic acid. The claims have been amended accordingly. Withdrawal of the rejection is respectfully requested.

Rejection under 35 U.S.C. § 102

The Applicants acknowledge the anticipation rejection of Claims 25 - 29 over Maignan. Maignan merely discloses that 10-hydroxy-2-decenoic acid promotes skin desquamation and stimulates epidermal renewal at Column 3, lines 6 - 11. Such disclosure has nothing to do with Claims 25 - 29 and does not anticipate them. Maignan does not explicitly or implicitly disclose any of preventing or treating degradation of collagen, preventing or treating degradation of collagen by bacterial collagenases during a bacterial infection, regenerating ligaments, preventing or treating tumoral invasion, preventing or treating degenerative diseases having fibrinoid degeneration of collagen, or reducing weight in patients as recited by those claims. Accordingly, Maignan does not anticipate Claims 25 - 29.

The Applicants note with appreciation the helpful comments in the Official Action at paragraph 3 that "[t]he mode that is cited [sic] for all of these aging ailments are [sic] collagen" However, the mode that Maignan repeatedly cites for combating skin aging is the des-

quamation and epidermal renewing properties of the compound, not collagen. The Applicants invite the Examiner's attention to the following statement under the "Summary of Invention" at Column 2 of Maignan:

"Accordingly, a major object of the present invention is the provision of novel compounds and active agents which ***promote desquamation of the skin and/or which stimulate epidermal renewal***, while at the same time avoiding the stinging, pricking, stabbing pains or sensation of heat or redness which are unpleasant for the user and which to date have characterized the state of this art." Emphasis added.

Such disclosure does not put one in possession of the subject matter of Claims 25 - 29, and such disclosure is not sufficient to establish anticipation. The Applicants respectfully submit that Claims 25 - 29 are not merely drawn to promoting desquamation or stimulating epidermal renewal or even combating aging. Rather, Claims 25 - 29 affirmatively recite administration to particular patients for particular, claimed indications. This is sharply different from mere desquamation promotion or epidermal renewal. The mere knowledge of the compound recited in Claims 25 - 29 and its utilities for promoting skin desquamation and epidermal renewal or even combating skin aging is not sufficient to anticipate Claims 25 - 29. Maignan nowhere explicitly or implicitly discloses administering a therapeutically effective amount of the recited compound for the particular purposes set forth in Claims 25 - 29. Thus, no inherency has been demonstrated on the record. Accordingly, Claims 25 - 29 are not anticipated. Withdrawal of the rejection is respectfully requested.

Rejection under 35 U.S.C. § 103


The Applicants acknowledge the obviousness rejection of Claim 30 over Kameda. Kameda discloses a decrease in lipolysis and stimulation of lipogenesis via trans-10-hydroxy-2-decenoic acid. The Applicants note, however, that such activity, in contrast to Claim 30, would *increase*, and not decrease, weight. In contrast to Kameda, the Applicants have shown an

increased lipolysis of adipocytes by treating these cells with trans-10-hydroxy-2-decenoic acid, and this activity gives rise to weight loss. Such disclosure by Kameda appears to be the opposite of what is claimed in Claim 30. The Applicants respectfully submit that doing the opposite of what the prior art teaches strongly compels allowability of Claim 30. Withdrawal of the obviousness rejection of Kameda is respectfully requested.

Conclusion

This application is now believed to be in immediate condition for allowance. The claims present patentable subject matter, and the Examiner is kindly requested to pass this application to issue. Should the Examiner wish to discuss this case or have any suggestions to place it into even better condition for allowance, she is kindly invited to contact the Applicants' below-signed representative by telephone at the number provided.

Respectfully submitted,


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